REMARKS

In response to the Office Action of May 27, 2005, Applicants have amended the claims, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration and allowance of all pending claims is respectfully requested. The amendments to the claims have been made in the interest of expediting prosecution of this case. Applicants reserve the right to prosecute the same or similar subject matter in this or another application.

Claims 1-37 are pending in this application. By this Amendment, Claim 1 has been amended to conform the language of step (c) to the language of step (a), Claim 11 has been amended to correct its dependency and Claim 30 has been amended to conform the language to Claim 23 from which it depends. Applicants respectfully submit that no new matter has been added to this application. Moreover, it is believed that the claims as presented herein places the application in condition for allowance.

The Examiner has rejected Claims 11 and 12 under the second paragraph of 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each of the rejections will be addressed in turn.

With respect to Claim 11, it is the Examiner's belief that Claim 11 is indefinite for reciting that the step of agitation comprises ultrasonic agitiation whereas Claim 10, from which Claim 11 depends, recites that the step of agitation comprises mechanical stirring. Claim 11 has been amended to depend from Claim 9 which recites that the step of mixing is accomplished by agitation. Accordingly, Claim 11 is believed fully definite as to comply with the second paragraph of 35 U.S.C. §112.

With respect to Claim 12, it is the Examiner's apparent belief that Claim 12 is indefinite since it is not clear when the base oil and/or additive are heated during the method. However, it is a well established rule that "whether a claim is invalid for indefiniteness requires a determination whether those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Morton International Inc.* v. *Cardinal Chemical Co.*, 28 USPQ2d 1190, 1194-95 (CAFC 1993). The specification at page 20, lines 1-7, clearly sets forth that the base oil and/or additive can be heated either prior to mixing, during mixing or after mixing. As such, one skilled in the art would readily understand what is meant by the recitation "further comprising the step of heating the base oil of lubricating viscosity or lubricating oil additive or both." as presently recited in Claim 12 when reading the contents of the specification. Accordingly, Claim 12 is believed to be sufficiently clear and definite as to comply with the requirements for definiteness under the second paragraph of 35 U.S.C. §112.

The Examiner has provisionally rejected Claims 1, 13 and 14 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 20, 22 and 23 of co-pending Application No. 10/699,529. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has rejected Claims 1-35 under 35 U.S.C. §103(a) as being obvious over Kolosov et al. U.S. Patent Application Publication No. 2004/0123650 ("Kolosov").

As acknowledged by the Examiner, nowhere does Kolosov disclose or suggest a method for preparing a plurality of different lubricant oil formulations comprising (a) providing a major amount of at least one base oil of lubricating viscosity and a minor amount of at least one lubricating oil additive for combination to formulate a lubricating oil composition; (b) providing

a plurality of test reservoirs; (c) combining, under program control, the major amount of the base oil of lubricating viscosity and lubricating oil additive in varying percentage compositions to provide a plurality of different lubricating oil composition samples; and, (d) containing each of the different lubricating oil composition samples in the plurality of test reservoirs as presently recited in Claim 1. Nor, as also acknowledged by the Examiner, does Kolosov disclose or suggest a system for preparing a plurality of lubricant oil formulations, under program control, which comprises (a) a supply of at least one base oil of lubricating viscosity; (b) a supply of at least one lubricating oil additive; (c) a plurality of test reservoirs; (d) means for combining selected quantities of the at least one base oil of lubricating viscosity with selected quantities of the at least one lubricating oil additive to form a plurality of lubricating oil composition samples; and , (e) means for dispensing each lubricating oil composition sample in a respective test reservoir as presently recited in Claim 23.

According to the Examiner, although Kolosov fails to specifically teach that the combinatorial chemistry method and apparatus for testing of commercial products can be used for the testing of a plurality of samples containing a base oil of lubricating viscosity and a lubricating oil additive in varying percentages, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the method and apparatus taught by Kolosov et al. for such a purpose since Kolosov et al. teach that the combinatorial chemistry method and apparatus is applicable to the testing of any commercial flowable product such as lubricants, and also teach that the products tested may include additives such as detergents, etc. therein.

Rather, Kolosov discloses a system and method for screening a library of a multitude of genera of material samples for rheological properties. The genera of material disclosed in Kolosov which can be tested include polymeric materials, organic materials, amorphous materials, crystalline materials, macromolecular materials, small-molecule materials, inorganic materials, pure materials, mixtures of the materials, any commercial product itself or an ingredient or portion within a commercial product such as pharmaceuticals, coatings, cosmetics, adhesives, inks, foods, crop agents, detergents, protective agents, and lubricants, as well as gels, oils, solvents, greases, creams, foams and other whipped materials, ointments, pastes, powders, films, particles, bulk materials, dispersions, suspensions, and emulsions. As far as Kolosov is concerned, the detergents disclosed therein could be any detergent such as laundry detergents, dish detergents, fuel detergents, etc. Certainly, at no point is there any appreciation in Kolosov of a method and/or system for rapidly preparing a plurality of sample candidate lubricating oil compositions containing a major amount of at least one base oil of lubricating viscosity and a minor amount of at least one lubricating oil additive such that a high throughput preparation and subsequent screening of a vast number of diverse compositions can be achieved to identify leading lubricating oil compositions. Thus, nothing in Kolosov would lead one skilled in the art to modify the system and method for testing the genera of flowable material disclosed therein and arrive at the specifically recited method and system for preparing a plurality of different lubricant oil formulations comprising (a) providing a major amount of at least one base oil of lubricating viscosity and a minor amount of at least one lubricating oil additive for combination to formulate a lubricating oil composition.

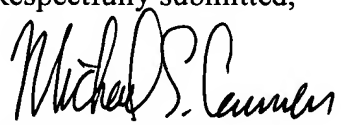
For the foregoing reasons, Claims 1-35 are believed to be nonobvious, and therefore patentable, over Kolosov. Accordingly, withdrawal of the rejection is respectfully requested.

The Examiner has rejected Claims 36 and 37 under 35 U.S.C. §103 (a) as being obvious over Kolosov in view of Shtein et al. U.S. Patent Application Publication No. 2005/0087131 ("Shtein").

The foregoing deficiencies of Kolosov discussed above with respect to the rejection of Claim 23 apply with equal force to this rejection. Shtein does not cure and is not cited as curing the above-noted deficiencies of Kolosov. Rather, Shtein is simply cited for the disclosure of depositing an organic material onto a substrate. Accordingly, Claims 36 and 37 are believed to be nonobvious, and therefore patentable, over Kolosov and Shtein.

For the foregoing reasons, Claims 1-37 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,



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